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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,499	06/25/1999	JOHN S. HENDRICKS	026880.00014	9133

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ARENT FOX LLP  
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SUITE 400  
WASHINGTON, DC 20036

EXAMINER
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ABEBE, DANIEL DEMELASH

ART UNIT	PAPER NUMBER
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2626

NOTIFICATION DATE	DELIVERY MODE
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08/10/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
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Patent\_Mail@arentfox.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/344,499	<b>Applicant(s)</b> HENDRICKS ET AL.	
	<b>Examiner</b> Daniel D. Abebe	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13,22-27,29-34,43-54 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13,22-27,29-34,43-54 and 59-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Regarding the priority issues, the examiner admits that some of the elements in the claims, such as, the ones quoted in the remark have support in the mentioned parent application and therefore enjoy the priority date of the patent filing date which is **11/7/1994**.

therefore the prior arts for addressing those elements will have an effective filing date prior to November 7, 1994.

the issue as explained in the office action is the cited parent application doesn't give support for some of the claimed elements in the present application namely **providing the text of an electronic book or/and the prompts in audio form** and therefore the date for addressing these elements of the claims is the filing date of the application, which is 6/25/1999.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5, 8-13, 22-26, 29-34, 43-54 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimune et al. (6,438,233) and in view of Sears et al. (6,115,482)**

As to claims 1, 43 and 51 Yoshimune (Fig.5) teaches a method of providing an electronic books comprising the steps of:

selecting an electronic book from a list of available electronic books stored (52) in an operation data center (50), where the operation center is remote;

receiving the selected book and displaying the pages on a terminal (55) display see (Figs.5-11, 16-22, 31, 32, 36-42 and 51-53; Col.12, line 34-Col.13, line 55).

It is noted that Yoshimune doesn't explicitly teach the claim limitation where the displayed electronic text materials are **"provided as audio"**.

Sears, however teaches a method for providing an electronic book in audio form utilizing text to speech conversion of a text material that is displayed on a display device wherein the text material comprises electronic books, magazines, newspaper etc, comprising the steps of receiving selection of the text and synthesizing the speech (Fig.1; abstract; Col.3, lines 20-50; Col.4, lines 12-33; Col.4, line 66-Col.5, line 5; Col.6, lines 13-20).

providing the electronic book would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the purpose of allowing people to listen instead of reading the book .

As to claims 2-3, 45-46 and 53-54, Sears teaches controlling the speed and the style of the audio corresponding to text (Col.6, lines 13-20; Col.9, lines 55-65; Col.10, lines 16-30) and Quentin teaches where the user interrupts the audio presentation of the text by the multimedia through commands (Col.13, lines 50-55) therefore, pausing and resuming the audio are inherent in light of these features.

As to claims 4, 44 and 52, Sears teaches where definitions/translations are verbally provided for words selected by the user (Col.10, lines 5-15).

As to claims 5 and 49, Sears teaches adjusting the rate of the audio output corresponding to the text and the user command (Col.9, lines 55-65).

With regard to claim 8, Yoshimune teaches the method for selecting a book where the book is accessed from a remote location and displaying the selected book for reading and Sears teaches where the displayed pages are verbally read by an electronic book system as addressed above.

As to claims 9-10, Sears teaches controlling the speed and the style of the audio corresponding to text (Col.6, lines 13-20; Col.9, lines 55-65; Col.10, lines 16-30) and pausing and resuming the audio are inherent in light of these features.

As to claim 11, the method is analogous to claims 1 and 8 above and therefore rejected by Yoshimune in view of Sears for the foregoing reasons.

As to claims 12-13, Sears teaches controlling the speed and the style of the audio corresponding to text (Col.6, lines 13-20; Col.9, lines 55-65; Col.10, lines 16-30) and pausing and resuming the audio are inherent in light of these features.

With regards to Claims 22-26 and 29-34, the corresponding apparatus for performing the claimed method of providing text into audio form is analogous and therefore rejected by Yoshimune in view of Sears.

As to claims 47-48, Yoshimune teaches where the displayed text includes digital video image and Sears teaches where the system speaks aloud text corresponding to the displayed video images and displayed text when

the user requests a more detailed explanation (Fig.8; Col.21, lines 28-32).

**As to claim 50, Official Notice is taken that providing prompts in audible form is well known in the art at the time of applicant's invention and would have been obvious in view of the prior arts of record as an alternative to the text prompts.**

As to claims 59-62, the presentation of the audio output in Sears is in real time where the text is synthesized using audio files.

**Claims 6 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimune (6,438,233) in view of Sears et al. (6,115,482) and further in view of Huffman et al. (5,663,748).**

With regard to claims 6 and 27, Sears teaches providing an electronic book in audible form, however he doesn't explicitly teach selecting the voice.

Huffman teaches a system for providing an electronic book in audio form by synthesizing speech from the text comprising a customized voice dictionary (Figs.1-6; Col.7, lines 35-45) wherein the voice dictionary comprises voice font for presenting the electronic book is selected (Fig.10; Col.7, lines 45-54). It would be obvious to one of ordinary skill in the art at the time of applicant's invention to combine the teachings for the purpose of providing the audio output in a voice of the user choice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohara et al. (5,485,176) audibly reading an electronic text book.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel D. Abebe whose telephone number is 571-272-7615. The examiner can normally be reached on monday-friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel D Abebe/  
Primary Examiner, Art Unit 2626